

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** MICHAEL HABELE

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Appeal No. 98-0685  
Application No. 08/513,529<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER, and ABRAMS, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

Michael Habele (the appellant) appeals from the final rejection of claims 1, 2 and 5-11, the only claims remaining in the application.

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<sup>1</sup> Application for patent filed August 10, 1995.

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We REVERSE and, pursuant to our authority under the provisions of 37 C.F.R. § 1.196(b), we will enter a new rejection of the appealed claims under 35 U.S.C. § 112, second paragraph.

The appellant's invention pertains to a screwing device for ultrasound-controlled tightening of screw connections. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the APPENDIX to the brief.

The references relied on by the examiner are:

Pagano 1976	3,969,810	Jul. 20,
Farley 1981	4,266,453	May 12,
Miner et al. (Miner) 1995	5,448,930	Sep. 12,
Canadian Patent (Ferm) 1958	566,987	Dec. 2,

Claims 1, 2 and 5-7, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pagano in view of Miner.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pagano in view of Miner and Farley.

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Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pagano in view of Miner and Ferm.

Each of these rejections is bottomed on the examiner's view that it would have been obvious to have substituted in Pagano, for the socket connection 44, 46, the socket connection shown by Miner in Figs. 8-10. However, for reasons stated *infra* in our new rejection entered under the provisions of 37 C.F.R. § 1.196(b) no reasonably definite meaning can be ascribed to certain language appearing in the claims. In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based on speculations and assumptions (*see In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)), we are constrained to reverse the rejections of claims 1, 2 and 5-11 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the § 103 rejections.

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Under the provisions of 37 C.F.R. § 1.196(b) we make the following new rejection.

Claims 1, 2 and 5-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention. Initially, we note that a decision as to claim indefiniteness requires a determination whether those skilled in the art would understand what is claimed.<sup>2</sup> **Amgen Inc. v. Chugai Pharmaceutical Co.**, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991). Moreover, the purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate

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<sup>2</sup> The function of the claims is (a) to point out what the invention **is** in such a way as to distinguish it from what was previously known, i.e., from the prior art; and (b) to define the **scope of protection** afforded by the patent. **In re Vamco Mach. & Tool, Inc.**, 752 F.2d 1564, 1577 n.5, 224 USPQ2d 617, 625 n.5 (Fed. Cir. 1985).

the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Turning to the claimed subject matter, independent claim 1 requires that the pin forming the connecting body engage the rotary drive shaft of the screwing tool "in said [at least partially] annular groove in a positively locking manner in **a region** of said edges"<sup>3</sup> (emphasis added). Where, as here, words of degree are used (i.e., "in a region of"), it is necessary to determine whether the specification provides some standard for measuring that degree. *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). Reviewing the appellant's specification, we find no explicit guidelines to enable one skilled in the art to make a determination of what portion of the groove (which may or may not extend around the entire

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<sup>3</sup> The term "edges" apparently refers to the corners formed by two intersecting sides of the "polygonal insert" (i.e., the polygonally-shaped end of the drive shaft). We also observe that the recitation of an "at least partially annular groove" (1) does not define over an arrangement wherein the groove extends around the entire outer periphery of the polygonal insert and (2) appears to be misdescriptive since a groove on the outer periphery of a **polygonal** insert is not "annular."

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outer periphery of the polygonal insert) is to be included "in a region of said edges." Absent such guidelines, we are of the opinion that the artisan would not be able to determine the metes and bounds of the claimed invention with the requisite degree of precision and particularity. Indeed, this position is reinforced by the fact that the examiner contends the connecting body in Miner can, as a broad proposition, be considered to engage the groove "in the region of the edges" whereas the appellant vigorously contends that it cannot.

As this Board stated in *Ex parte Oetiker*, 23 USPQ2d 1651, 1655 (Bd. Pat. App. & Int. 1990), *aff'd mem.*, 1951 F.2d 1267, 23 USPQ2d 161 (Fed. Cir. 1991):

All things considered, because a patentee has the right to exclude other from making, using and selling the invention covered by a United States letters patent, the public must be apprised of what the patent covers, so that those who approach the area circum-scribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. *See In re Hammack, supra.*

Here, the public would not be apprised of the scope of the claimed subject matter.

In summary:

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The rejections of claims 1, 2 and 5-11 under 35 U.S.C. § 103 are reversed.

A new rejection of claims 1, 2 and 5-11 under 35 U.S.C. § 112, second paragraph, has been made.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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***REVERSED***  
***37 C.F.R. § 1.196(b)***

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
NEAL E. ABRAMS	)	
Administrative Patent Judge	)	

JMM/jlb



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